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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,034	11/08/2001	Michael John Hughes	32401-PCT/USA-A 066351.01	4204

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EXAMINER
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TOLAN, EDWARD THOMAS

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 07/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,034

Applicant(s)

HUGHES, MICHAEL JOHN *CH*

Examiner

Tolan Edward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 39-107 is/are pending in the application.
- 4a) Of the above claim(s) 76-95 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-42, 44-68, 70-75 and 96-107 is/are rejected.
- 7) ☒ Claim(s) 43 and 69 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/269,808.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 39-75 and 96-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claim 39, the phrase "adapted to displace" in line 3 renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. It is not understood how the apparatus is adapted, are external means provided that are not claimed? Applicant uses this language throughout the claims. The Examiner now points out the many instances of this language use. Claim 41, line 3, claim 42, line 3 and claim 43, line 3 "adapted to be mounted"; claim 48, line 2 "adapted for connection"; claim 56, line 2 "adapted to engage"; claim 73, line 2 "adapted to displace"; claim 96, line 1 "adapted to displace", line 2 "adapted to displace" and line 5 "adapted to break up"; and claim 99, lines 2 and 3 "adapted to engage".

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Using the term “move” for example, language such as “is operable to move”, “means for moving”, “moves” or “for moving” positively states movement, “adapted to” is not a positive recitation.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 39-41,44,45,47-52,54-68 and 70-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Dwyer et al. (5,209,413). Dwyer discloses bale conveyor (90), and dual shredding drums (92,94) for shredding a bale. The conveyor has transverse lugs (see figs. 5 and 8) which define a bale support surface, the conveyor chain operating as a bale displacement means to displace the bale off of the conveyor surface and through the drums. The conveyor forms a bottom of a bale receiving channel (88) which has side walls (89,93) adjacent to the bale support surface. The shredder is attachable to a vehicle. Regarding claim 49, Dwyer discloses pivotable support in column 3, lines 54-63. Regarding claims 62-66 Dwyer discloses push rod assembly (46) in column 3, lines 3-15. Regarding claims 67 and 68, Dwyer discloses in column 4, lines 30-48 that ring (124) and collar (130) do not allow twine to wrap around the shredding drum.

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6. *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer et al. (5,209,413) in view of Goossen (5,573,190). Dwyer does not disclose that the channel and shredding means are parallel to a vehicle travel direction. Goossen teaches channel (26) and shredder (28) that is parallel to a vehicle travel direction. It would have been obvious to dispose the shredding means parallel to the feed direction of the channel in Dwyer as taught by Goossen in order to shred a bale forward or backward in a straight line to a vehicle travel direction.

9. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer et al. (5,209,413) in view of Reyher et al. (5,865,589). Dwyer does not disclose tapered side walls. Reyher teaches that side wall (32) has an inclined section (33) and that side wall (34) gradually slopes. It would have been obvious to one skilled in the art at the time of invention to provide Dwyer with tapered walls as taught by Reyher in order to direct the bale toward a shredding means.

10. Claims 53 and 96-107 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer et al. (5,209,413) in view of Siebenga (5,211,345). Dwyer discloses bale conveyor (90), and dual shredding drums (92,94) for shredding a bale. The conveyor has transverse lugs (see

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figs. 5 and 8) which define a bale support surface, the conveyor chain operating as a bale displacement means to displace the bale off of the conveyor surface and through the drums. The conveyor forms a bottom of a bale receiving channel (88) which has side walls (89,93) adjacent to the bale support surface. The shredder is attachable to a vehicle. Dwyer does not disclose a pivotable shredding means. Siebenga teaches shredding roller (13) mounted on supports (19) that are pivotable by cylinder (17). It would have been obvious to one skilled in the art at the time of invention to provide Dwyer with a pivotable shredding means as taught by Siebenga in order to shred bales at differing angles.

11. *Allowable Subject Matter*

12. Claim 43 and 69 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

15. Any inquiry concerning this communication should be directed to Ed Tolan whose telephone number is 703-305-3021. ETT 7-1-03

ED TOLAN  
PRIMARY EXAMINER

